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In re Application of
MILSTEIN, Cesar et al.
Application No.: 10/506,906
PCT No.: PCT/GB03/00974
Int. Filing Date: 07 March 2003
Priority Date: 07 March 2002
Attorney's Docket No.: DYC0101PUSA
For: SCD FINGERPRINTS

DECISION ON

REQUEST

UNDER 37 CFR 1.42

This application is before the Office of PCT Legal Administration for matters arising under 35 USC 371. A review of the declaration reveals an indication that joint inventor Cesar Milstein is deceased. Applicants' submission has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 07 March 2003, applicants filed international application PCT/GB03/00974, which claimed a priority date of 07 March 2002. A copy of the international application was transmitted to the Office by the International Bureau on 12 September 2003. The deadline for entry into the national stage in the United States was 07 September 2004.

On 07 September 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 30 March 2005, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

The declaration is signed by an executor. The declaration must list the inventors and their citizenships and the legal representative and the legal representative's citizenship, residence and postal address. See 37 CFR 1.497. The declaration appears to list the information for the inventors, including the Cesar Milstein, but does not list the required information for the legal representative, Ms. Celia Prilleltensky Milstein.

Additionally, the legal representative and the third inventor are named inconsistently. The third joint inventor is listed as Charles Nicholas Hales on the declaration, but was listed as C. N. Hales on the international application. An inventor is required to be listed by at least one given name. A petition to change Inventor Hales' name under 37 CFR 1.182 is required. MPEP §605.04(c). Legal Representative Celia Prilleltensky Milstein was listed as "Prilleltenski Milstein" on the international application and on the printed declaration, but she altered it to read "Prilleltensky Milstein." If this discrepancy was the result of a typographical error, it may be corrected under MPEP 201.03. Otherwise, it can be corrected with the inventor name change petition.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. **THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.** Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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